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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,645	09/26/2003	Kirk A. Buhler	KB01-02U	8215
37038	7590	10/12/2005	EXAMINER	
BUHLER ASSOCIATES BUHLER, KIRK A. 1101 CALIFORNIA AVE. SUITE 208 CORONA, CA 92881			JULES, FRANTZ F	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/672,645

Applicant(s)

BUHLER ET AL.

Examiner

Frantz F. Jules

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recitation of "a third cover member connected with a bearing to the first or second member" in claims 6 and 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

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2. The disclosure is objected to because of the following informalities:

The specification fails to disclose to an ordinary skill in the art how to construct an outer member which is made from a material consisting of metal, plastic and rubber as recited in claims 4 and 11.

Appropriate correction is required.

***Claim Objections***

3. Claims 4-5, 11-12 are objected to because of the following informalities:

In claim 4, line 2, the phrase —at least one of—should be added in front the word metal to improve the clarity of the claim language and to be consistent with the specification. Similar correction should be made to claim 11.

In claim 5, line 2, the phrase —at least one of—should be added in front the word ball bearings to improve the clarity of the claim language and to be consistent with the specification. Similar correction should be made to claim 12.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, line 2, the phrase "the bearings" is confusing as it lack antecedent basis since only a bearing mechanism has been previously recited. Also, it claims plural.

Similar problem exists in claim 12

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 5, 7-9 and 14 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by Good (US 2004/0075332 A1).

Good discloses a wheel cover for a vehicle comprising an inner member (16) with attachment mechanism (18) for connecting to a vehicle rim, at least one outer member (12) that is not eccentrically weighted, a bearing mechanism (22) that connects the inner member to the outer member to allow the members to turn independently from each other as disclosed in the abstract. The outer member is located on the axis of the inner member as shown in fig. 2-3.

8. Claims 1, 4, 7-9, 11 and 14 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by Wang (6,702,396).

Wang discloses a wheel cover for a vehicle comprising an inner member (42) with attachment mechanism (44) for connecting to a vehicle rim, at least one outer member

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(18) that is not eccentrically weighted, a bearing mechanism (481) that connects the inner member to the outer member to allow the members to turn independently from each other as disclosed in the abstract. The outer member is located on the axis of the inner member as shown in fig. 2-3.

The outer member is made from a group of materials consisting of at least one of metal, plastic or rubber in accordance with claims 4 and 11.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 5-6, 9, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US 6,702,396 B1) in view of Wallach (US 6,820,475).

Claims 2 and 9

Wang teaches all the limitations claims 2 and 9 except for a wheel cover comprising an attachment mechanism consisting of clips or springs. The general concept of providing an attachment mechanism consisting of spring and clips to a wheel cover is well known in the art as illustrated by Wallach which discloses the teaching of clips or springs (24) to locate a wheel cover, see fig. 2. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wang to include the use of an attachment mechanism comprising springs or clips in his advantageous wheel cover as taught by

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Walach in order to facilitate installation of the wheel cover thereby removing the risk of personal injury.

Claims 5, 12

Regarding using bearings made from ball bearings, plastic bearings and bronze bearings as recited in claims 5 and 12, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wang to include the use of bearings made from ball bearings, plastic bearings and bronze bearings in his advantageous system, as material selection is a common and everyday occurrence throughout the wheel cover design art and the specific use of bearings made from ball bearings, plastic bearings and bronze bearings would have been an obvious matter of design preference depending upon such factors as the wind loading imposed on the wheel cover, the maximum speed of the vehicle, the yield strength of the bearing and the outer member; the ordinarily skilled artisan choosing the best stress profile corresponding to a particular loading imposed on the wheel cover which would most optimize the cost and performance of the device for a particular application at hand, based upon the above noted common design criteria.

Claims 6 and 13

Regarding using a third cover member connected with the bearing to the inner and outer member as recited in claims 6 and 13, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wang to include the use of a third cover member connected with the bearing to the inner and outer member in his advantageous system, as the duplication /reduction of identical parts which perform

essentially the same function is a common occurrence throughout the wheel cover design arts, and the specific number of cover member used on a wheel cover would have been an obvious duplication of parts, depending upon such common factors as the loading imposed on the wheel cover, the yield strength of the bearing and cover material, the weight of the wheel cover; the ordinarily skilled artisan choosing the best number of cover members which would most optimize the cost and performance of the device for a particular application at hand, based upon the above noted common design criteria.

11. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US 6,702,396 B1) in view of Miyanaga (US 3,367,722).

Whiteman teaches all the limitations claims 3 and 10 except for a wheel cover comprising an attachment mechanism consisting of one or more magnets. The general concept of providing an attachment mechanism consisting of one or more magnets to a wheel cover is well known in the art as illustrated by Miyanaga which discloses the teaching of one or more magnet (84') to locate a wheel cover (52), see fig. 3, col 2, lines 40-48. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wang to include the use of an attachment mechanism comprising one or more magnets in his advantageous wheel cover as taught by Miyanaga in order to simplify installation of the wheel cover thereby removing the risk of personal injury.

### ***Response to Arguments***



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12. Applicant's arguments filed 08/21/2005 have been fully considered but they are not persuasive.

A. Summary of applicant's argument

In the amendment, applicant traversed the rejection of the newly amended claims for the following reasons:

1. The reference cited in the 102 rejection, Whiteman, fails to meet the all of the criteria of anticipation since the amended limitations of the outer member located on the outer side of the inner member is not met.
2. The reference cited in the 102 rejection, Good, is not a proper reference under 102 (e)(1) as the filing date of April 22, 2004 of Good is less than that of the pending application filed on September 26, 2003.
3. The combination rejection of Whiteman and Miyanaga is improper since there is no teaching or motivation to combine the references.

B. Response to applicant's argument

1. Applicant's argument NO. 1 is moot in light of the fact that the rejection of the claims over the Whiteman reference has been lifted and substituted by Wang.
2. In response to applicant's argument No. 2, it must recognized that the Good patent claims the benefit of an earlier filed application which is dated July 24, 2002. Thus, being a continuation-in-part of an earlier filed application, the effective date of the Good patent goes back to July 24, 2002 which predates the filing date of September 26, 2003 of the current application.

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3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, an ordinary skill in the art would have been motivated to incorporate the use of an attachment mechanism consisting of one or more magnet to retain the inner member to the vehicle rim as taught by Miyanaga into the wheel cover of Wang in order to achieve among others the benefit of improving the aesthetics of the wheel.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz F. Jules whose telephone number is (703) 308-8780. The examiner can normally be reached on Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph S. Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz F. Jules  
Primary Examiner  
Art Unit 3617

FFJ

June 21, 2005

**FRANTZ F. JULES**  
**PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'Frantz F. Jules', with a stylized, flowing script.